

REMARKS

The indication that claims 3 and 12 would be allowable if re-written to overcome the rejections under 35 USC §112, second paragraph and to include all of the limitations of the base claim and any intervening claims, is acknowledged. However, applicants have retained such claims in dependent form at this time.

By the present amendment, independent claim 1 and some of the dependent claims have been amended to clarify features thereof, which amendments are considered to overcome the rejection of the claims under 35 USC §112, second paragraph, it being noted that claims 15-21 stand withdrawn from consideration.

As to the rejection of claims 1 and 8 under 35 USC §112, second paragraph, such rejection is traversed insofar as it is applicable to the present claims.

By the present amendment, claim 1 has been amended to delete the phrase "wherein the plurality of first parts are distributed in the second part separately" such that applicants submit that claim 1 by the deletion of the phrase overcomes the Examiner's rejection of such claim under 35 USC §112, second paragraph. Additionally, claim 1 has been amended to clarify the features of the present invention that the second part includes derivatives of at least a respective one of the dyestuff molecules, with corresponding language being utilized in the remainder of claim 1 and other claims of this application, so as to more clearly set forth the features of this invention and to utilize corresponding language throughout. Thus, applicants submit that claim 1, as amended, should be considered to be in compliance with 35 USC §112, second paragraph.

With respect to claim 8, it appears that the Examiner contends that claim 8 does not further limit claim 1. However, applicants note that claim 8 depends from

the claim 1, and recites the feature that "the derivatives dissolved in the second part of the optical region are classified into at least two kinds obtained by chemical modification of at least two kinds of dyestuff molecules respectively" (emphasis added), with the remaining part of claim 8 reciting feature that "the dyestuff molecules aggregated at the plurality of first parts of the optical region belong to one of the at least two kinds of dyestuff molecules" (emphasis added). Thus, applicants submit that the Examiner has mischaracterized the claimed features of claim 8, and the features of claim 8 are not inherently contained in claim 1, and claim 8 recites further features of the present invention, as is apparent from the emphasis portion provided. Accordingly, applicants submit that claim 8 should be considered to be in compliance with 35 USC §112, second paragraph.

As to the rejection of claims 1-2, 4-11 and 13-14 under 35 USC §102(b) as being anticipated by Schädeli et al (USP 6,180,315), this rejection is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In Re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999)*, wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and

that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Applicants submit that irrespective of the contentions by the Examiner, Schädeli et al '315 does not disclose the features of claim 1, including the feature of "a second part including derivatives of at least a respective one of the dyestuff molecules". More particularly, Schädeli et al '315 at column 45, lines 2-4, provides that "the portion of the composition in which pigment is not regenerated is removed by using an appropriate developer," (emphasis added) with respect to fabrication of a color filter for an LCD. Assuming *arguendo*, that such portion represents derivatives of at least a respective one of the dyestuff molecules, although applicants submit that such PORTION does not represent derivatives as defined, such portion is removed, so that it is apparent that Schädeli et al '315 does not disclose the recited features of claim 1 in the sense of 35 USC §102, and applicants submit that claim 1 and the dependent claims patentably distinguish over Schädeli et al '315 and should be considered allowable thereover.

With respect to the dependent claims, in addition to the Examiner recognizing the patentability of claims 3 and 12 over the cited art, applicants submit that the Examiner has misinterpreted the recitation of claim 8, as pointed out above, and applicants submit that such features are also not disclosed by Schädeli et al '315. Likewise, applicants submit that the other dependent claims when considered in conjunction with the parent claims thereof, further patentably distinguish over

Schädeli et al '315, such that all dependent claims under consideration should be considered allowable together with independent claim 1.

In view of the above amendments and remarks, applicants submit that the rejection under 35 USC §112, second paragraph, should now be overcome and that in addition to claims 3 and 12, which have been indicated as being objected to, claims 1, 2, 4-11 and 13, 14 should also now be in condition for allowance. Accordingly, issuance of action of a favorable nature is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 501.43299X00), and please credit any excess fees to such deposit account.

Respectfully submitted,
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